

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appln. No. 09/585,460 (**45391.00003 UTL1**)

REMARKS/ARGUMENTS

Claim Objections

Paragraph 2 of the action objects to claim 69 because a period is missing after the number 69. Applicant has cancelled claim 69 thereby rendering this objection moot. Accordingly, Applicant respectfully requests that the objection be withdrawn.

Claim Rejections Under 35 U.S.C. §102

Paragraph 3 of the Action rejects claims 30-32, 51, and 54 under 35 U.S.C. §102(b) as being anticipated by Gregorek. Applicant has cancelled claims 30-32, 51, and 54 in the above amendments thereby rendering this rejection moot. Accordingly, Applicant respectfully request withdrawal of the rejection as to claims 30-32, 51, and 54. Applicant expressly reserves the right, however, to pursue any patentable subject matter included in claims 30-32, 51, and 54 at a later time.

Claim Rejections Under 35 U.S.C. §103

Paragraph 4 of the Action rejects claims 13, 33-43, 49-50, 55-59, 65-66, 69-70, 76, and 77 under 35 U.S.C. §103(a) as being obvious in light of Gregorek. Applicant has cancelled claims 55, 56, and 69-70 in the above amendments thereby rendering this rejection moot as to these claims. Accordingly, Applicant respectfully request withdrawal of the rejection as to claims 55, 56, and 69-70. Applicant expressly reserves the right, however, to pursue any patentable subject matter included in claims 55, 56, and 69-70 at a later time.

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With regard to the remaining claims, Applicant respectfully traverses this rejection because Gregorek fails to teach, suggest, or disclose every element of claims as amended.

With respect to amended claim 13, Applicant respectfully submits that Gregorek fails to teach, suggest, or disclose “[a] telecommunications advertising system comprising an advertisement database that stores subscriber specific or third party advertisements, and a processor . . . configured to selectively associate, . . . at least one advertisement in the advertisement database with a destination of an incoming communication and to route the associated advertisement to the destination.”

The Action admits that Gregorek does not teach associating an advertisement with the destination of the incoming communication. The Action states, however, that it would have been obvious to one of ordinary skill in the art at the time of the invention. As an example, the Action notes that if one were to call Macy’s an advertisement associated with Macy’s would often be played for the user through their telephone. Applicant asserts that the given example is, in the language and examples of the present application, an example of an advertisement, which is itself associated with the destination, being associated with, and routed to, the source of the call.

But claim 13 as amended requires that an advertisement be associated with and routed to the destination. This is not taught, as the Action admits, in Gregorek. Nor does Gregorek provide any motivation to modify the teachings of Gregorek to achieve the invention as claimed in claim 13. Accordingly, Gregorek alone fails to support a *prima*

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facia case of obviousness and Applicant respectfully requests withdrawal of the rejection as to claim 13.

Claims 33, 35, and 36 depend from claim 13, Applicant, asserts that claims 33, 35, and 36 are allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to these claims.

Claim 34 depends from claim 13, Applicant, asserts that claim 34 is allowable over the art of record for at least the reasons stated with respect to claim 13. Further, Applicant asserts that Gregorek does not teach replacing the rings of the ring back signal with a plurality of short advertisements as required by claim 34.

Gregorek teaches replacing the entire ringback signal with one continuous message that is 5 – 30 seconds long (see Col. 11, lines 18-25). This is not the same as replacing the individual rings of the ring back signal with a short advertisement as described in the present application (see page 8, lines 7-9) and claimed in claim 34. As explained in the present application, a ringback signal comprises a plurality of short rings (see page 8, lines 7-9). It should be well understood that these rings a very short, i.e., a fraction of a second. Thus, unlike Gregorek, the present application teaches that very short advertisements can be used in place of the rings of the ringback signal. As noted in the present application, this is different than replacing the entire ringback signal with a continuous advertisement (see page 8, lines 27-30).

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Applicant respectfully request withdrawal of the rejection as to claim 34, because Gregorek fails to teach replacing the individual rings of the ringback signal with short advertisements.

Claims 37 and 58 depend from claim 13, Applicant, asserts that claims 37 and 58 are allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to these claims. Further, applicant asserts that the rejection put forth is incomplete. The Action appears to state that Gregorek teaches that the message associated with the destination is routed to the destination when the destination goes off hook. Applicant has reviewed Gregorek in its entirety and was unable to find any such teaching in Gregorek. The section of Gregorek cited in the Action does not discuss routing an advertisement to the destination of an incoming communication.

Claim 38 depends from claim 13, Applicant, asserts that claim 38 is allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to this claim. Further, Applicant asserts that Gregorek does not teach routing advertisements to the destination of an incoming communication using either audible signal generator 24 or message generator 26. Rather, audible signal generator 24 or message generator 26 are used to route signals to the source of the incoming communication.

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Claims 39-43, and 59 depend from claim 13, Applicant, asserts that claims 39-43, and 59 are allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to these claims.

Claims 49 and 50 depend from claim 13, Applicant, asserts that claims 49 and 50 are allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to these claims.

Claim 57 depends from claim 13, Applicant, asserts that claim 57 is allowable over the art of record for at least the reasons stated with respect to claim 13 and respectfully request withdrawal of the rejection as to this claim.

With respect to claims 76 and 83, Applicant respectfully asserts that Gregorek fails to teach suggest and disclose every element of these independent claims for at least the reasons stated with respect to claim 34. Accordingly, Applicant respectfully request withdrawal of the rejection as to claims 76 and 83.

Claim 77 depends from claim 76, Applicant, asserts that claim 77 is allowable over the art of record for at least the reasons stated with respect to claim 76 and respectfully request withdrawal of the rejection as to this claim.

Paragraph 5 of the Action rejects claims 44-48, 52, 53, 60-64, 67, 68, 71-75, and 78-82 under 35 U.S.C. §103(a) as being obvious in light of Gregorek in further view Kung. Applicant has cancelled claims 52, 53, 67, 68, and 71-75 in the above amendments thereby rendering this rejection moot as to these claims. Accordingly, Applicant respectfully request withdrawal of the rejection as to claims 52, 53, 67, 68, and

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71-75. Applicant expressly reserves the right, however, to pursue any patentable subject matter included in claims 52, 53, 67, 68, and 71-75 at a later time.

With respect to the remaining claims, claims 44-48 and 60-64 ultimately depend from independent claim 13 and claims 78-82 ultimately depend from independent claim 76. Gregorek is deficient with respect to independent claims 13 and 76 for at least the reasons stated above. Therefore, the Examiner must rely on Kung to compensate for the foregoing deficiencies.

Kung is drawn to a chase me system (See e.g., Title). More specifically, Kung describes in detail a method of routing Internet broadband communications between or among users without relation to their locations. Thus, Kung describes a method to chase called parties through a broadband Internet Protocol Telephony Network (IPTN) and a public switched telephone network. (See Col. 1, lines 8-15). Although Kung teaches the use of an announcement server to track the user's age, salary or other profile, Kung is not directed to advertising via a telecommunication system nor does Kung disclose, teach or suggest associating an advertisement with a destination of an incoming call or replacing ring tones with an advertisement. Therefore, Kung cannot and does not compensate for the deficiencies of Gregorek with respect to independent claims 13 and 76. Applicant therefore respectfully submits that claims 44-48, 60-64, and 78-82 are patentable at least by virtue of their dependency. The Examiner is therefore respectfully requested to withdraw the § 103(a) rejection from claims 44-48, 60-64, and 78-82.

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CONCLUSION

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. No fee for additional claims are believed to be necessitated by this amendment. A check for a three month extension of time is included herewith. The Commissioner is directed and authorized to charge all additional required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 50-2613. Please also credit any overpayments to said Deposit Account.

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Respectfully submitted,

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